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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/332,846 06/14/99 LANDRY G MPS/30

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LM02/0719

EXAMINER

ALVAREZ, R

ART UNIT

PAPER NUMBER

2761

7

DATE MAILED:

07/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/332,846

Applicant(s)
George W. Landry

Examiner
RAQUEL ALVAREZ

Group Art Unit
2761



☒ Responsive to communication(s) filed on Apr 24, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 25-88 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 42-56 and 74-88 is/are allowed.

☒ Claim(s) 25-41 and 57-73 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 25-88 are presented for Examination.

Double Patenting

2. Claims 25-88 are rejected under the judicially created doctrine of double patenting over claims 1-24, of U. S. Patent No. 5,649,117 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: storage for payee information for each of a plurality of payees, storage information for each of plurality of payors, control parameters defining the manner in which transfers are to be performed, message generation corresponding to the transfer of funds, maximum amount identified by the payor to the payee, minimum interval identified by the payor to the payee, payor information corresponding to a government account, a period of time during which the payor may cause a reverse transfer.

Furthermore, the present claims are broader in scope and there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 U.S.C. § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25-33, 35-41 and 57-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Kight et al. (5,383,113 hereinafter Kight) in view of Pickering(5,483,445 hereinafter Pickering).

A. With respect to claims 25- 28, and 57-60, Kight discloses a bill payment system having storage for payee information(col. 3 lines 30-54), storage for payor information for each of a plurality of payors, the payor information for a payor identifying a plurality of payees authorized by the payor to receive transfer of funds from the payor(i.e. the payor(consumer) informs the service provider or processor of a payee's(merchant) name, address, phone number and the consumer's account number with the merchant. This information is stored into a merchant master file database)(col. 3, lines 3, lines 30-36), and control parameters defining the manner in which transfer of funds are to be performed(i.e. control and payment parameters established by the consumer)(col. 68 to col. 2, line 2).

Kight does not specifically teach: a payee communications interface receiving bill data from each of said payees. Nevertheless, Pickering discloses an automated bill paying system

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which serves a plurality of payors and a plurality of payees, Periodic electronic transfer of billing information from payees to the bill paying system(Abstract, lines 4-7) is disclosed. It would therefore have been obvious to one skilled in the art to add electronic transfer of bill data from payees to the bill paying system of Kight because it would relieve the consumers of the burden of transferring this information themselves and it would be more efficient than the payees transferring this information outside the system.

Pickering also teaches funds transfer interface generating one or more electronic funds transfer messages to the payee and the payor(col. 8, lines 1-23). It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to have sent a electronic transfer message to the consumer and the merchant of Kight because such a modification would confirm the transaction to the parties involved.

B. As per claims 29 and 61, Kight further teaches that the interactive device comprises a telephone under the control of the payor, and said transactions are presented to a payor via the telephone(abstract and col. 3, lines 55-, col. 4, lines 1-28).

C. Claims 30 and 62 further recite that the transactions are presented to the payor via an automated teller machine(ATM). Kight teaches that the transactions are presented to the payor via telephone, computer terminal or other telecommunication means(abstract). Kight does not specifically teach an ATM. An ATM like the computer terminal and the telephone interface provides the customer with more choices to choose from.

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D. With respect to claims 31-34 and 63-66, Kight further teaches that the transactions identify a date by which funds are to be transferred from a payor to a payee in payment of a bill(Figure 3 and col. col. 3, lines 30-54).

E. With respect to claim 35-37 and 67-69, Kight further teaches identifying the payee as the one originating a bill, identifying a payee by name)(col. 3, lines 55-, col. 4, lines 1-28). Kight does not specifically teach identifying a payee by an identifier. Official notice is taken that is old and well known to use identifier for bearing identifying information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using an payee identifier because such a modification would provide a more reliable identification process.

F. With respect to claims 38 and 70, Kight further teaches presenting to the payor one or more functions, and the payor communication interface is responsive to a payor's selection of a function at the interactive device(Figure 3).

G. With respect to claims 40 and 72, the claims further recite: preventing transfer of funds which exceeds the maximum amount specified by the payor. Kight discloses the payors as setting the actual payment amounts. This teaches indirectly that a maximum amount is set when the payor sets that amount. The combination of Kight and Pickering differ from applicant's invention in that it does not specifically teach: preventing transferring of funds which exceeds the maximum amount specified by the payor. Nevertheless, it is well known in the computer related arts to have systems in which an error message is generated to let the user know that the system

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has encountered a problem and that it cannot proceed. Therefore it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to prevent transfer of funds, such as generating an error message, if the transactions did not meet predetermined criteria because it would give the user notification that the system has encountered an unapproved transaction and allow correction or investigation of the problem.

H. With respect to claims 41 and 73, the claims further recite: preventing a transfer of funds if any other transfer of funds for the payor and payee occurred during the minimum set time interval. Kight discloses payor-established time intervals between billings(col. 3, lines 44-45). This teaches indirectly that a minimum is set when the payor sets the time interval.

5. Claims 34 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kight, Pickering and further in view of Hilt et al.(5,465,206, Hilt hereinafter).

A. As per claims 34 and 71, the combination of Kight, Pickering differ from Applicant's invention in that it does not disclose that payors can send messages through the payor control interface which affect EFT transactions which reverse transfers which have been made due to payee-initiated modifications of the billing information. Hilt discloses an automated bill paying system serving a plurality of payees and a plurality of payors. Hilt, like Kight Pickering and addresses the problem of easing the burdens on the payor or payee of attending to numerous bills(Hilt, col. 1, lines 26-30). Hilt discloses payment reversal messages(col. 15, lines 29-38).

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Although the reversal message in Hilt is initiated by the bank or bill payment system rather than the payor, it does teach that reversal transactions are possible. It would have been obvious to a person of ordinary skill in the art to add a payor-initiated reversal option to the combination of Kight and Pickering in order to give the payors more control over their funds and the timing of payments and to allow correction of errors. The desirability of payor control is discussed in Hilt at col. 3, lines 32-34.

Allowable Subject Matter

6. Claims 42-56 and 74-88 allowed.

The Examiner asserts that the date of the transfer for at least one bill being determined absent payor intervention based on at least one of bill data for the bill, stored payor information, without regard to due dates of bills of other payees, is not taught in the prior art of record.

A terminal disclaimer must be filed to overcome the double-patenting rejection.

Response to Amendment

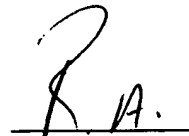
The terminal disclaimer on patent number 5956,700 was received and processed. A new terminal disclaimer on patent number 5,649,117 must be filed to overcome the new double-patent rejection.

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Points Of Contact

7. Any inquiry concerning this communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703) 305-0456. The examiner can normally be reached on Monday to Friday from 9:00 AM. To 5:00 PM.

If any attempt to reach the examiner by telephone is unsuccessful, The examiner's supervisor, Emanuel Voeltz can be reached on (703) 305-9714. The fax phone number for this group is (703) 305-0040.


Raquel Alvarez
Patent Examiner, AU 2761

July 16, 2000


EDWARD R. COSIMANO
PRIMARY EXAMINER